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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,218	03/29/2004	Ferdinand Kersten	251103-1021	3040

24504 7590 08/25/2004

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EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,218

Applicant(s)

KERSTEN, FERDINAND

Examiner

Flemming Saether

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/955,522
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not describe the transition between the first and second circumferential planes as “a buckle”. The buckle is used to describe the transition between the second and third circumferential planes.

Claim Objections

Claims 41-43 are objected to because of the following informalities: in claim 41, line 5, there is no antecedent for “the flat bottom” and should be changed to --a flat bottom-- and similarly in line 7, there is no antecedent for “the flank” and should be changed to --a flank—. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 41 and 42 the transition point where

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the circumferential wall changed into a flank being "curved" or "convex" is considered new matter since as described it is a "point" and a point cannot be considered as curved.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24, 29, 34 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each of the aforementioned claims, "preferably" is indefinite.

Double Patenting

Claims 21-41 and 43 are rejected under the judicially created doctrine of double patenting over claims 1-28 of U. S. Patent No. 6,712,570 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Kibblewhite (US 5,131,276). In the embodiment of Fig 8, Kibblewhite discloses threaded bolt comprising a head end having a outermost radial measurement plane and an insertion end having a radial measurement plane formed by a flat bottom (at 85, 87) of a recess bounded by a circumferential wall which has an outermost distal end at a point changes into a flank via a sharp buckle. The radial planes are used as ultrasonic measuring planes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-25, 27-35, 37-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over DAF Standard Prod 9257 in view of Kibblewhite (US 5,131,276). In Fig. 4 on page 6, DAF Standard discloses a threaded bolt for use in ultrasonic measurement for determining the tension in a threaded bolt. The insertion end of the

bolt (left side of Fig. 4) has a single flat radial measurement plane formed as a flat bottom of a recess bounded by a first circumferential plane at an angle of 45 to 75 degrees which at an outermost portion forms a sharp point (labeled "sharp") and "via a buckle" transitions into a second circumferential plane (not labeled) which is shown at an angle of 45 degrees or less. A head end of the bolt (right side of Fig. 4) is disclosed but, not as having a single flat perpendicular measurement plane. Kibblewhite disclose a bolt for ultrasonic measurement wherein in the embodiment of Figs. 1 and 2, the head is shown as having a single flat perpendicular measurement plane (15) and a further discloses a sensor (23) to be placed there against. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the head of DAF Standard with a single flat measurement plane as disclose in Kibblewhite since Kibblewhite discloses the single flat surface to a recessed flat surface as currently employed in DAF Standard (see DAF Standard Fig. 4, Detail B). The single flat surface would be superior because it would be easier to manufacture and thus more economical. The means by which the insertion end is formed is a product-by-process limitation where only the final product is considered for patentability. The insertion end is read as "truncated" and lastly, the first and second "normal" are read as opposite one another since there is no structure to preclude such an understanding.

Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over DAF Standard in view of Kibblewhite as applied to claims 21, 31 and 35 above, and further in view of Brown (US 2,778,265). Brown discloses a third circumferential

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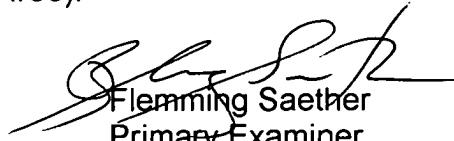
surface (20) at an angle of 35 degrees contiguously provided with a thread. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the bolt of modified DAF Standard with a third circumferential surface as disclosed in Brown to optimally form a transition in to the threads of the bolt.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Flemming Saether
Primary Examiner
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